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In re Application of LAZAREV et al
U.S. Application No.: 09/485,168
PCT Application No.: PCT/RU98/00250
Int. Filing Date: 03 August 1998
Priority Date: 04 August 1997
Attorney Docket No.: U 012593-1
For: LIQUID CRYSTAL DISPLAY

DECISION ON

RENEWED PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "Response to Decision on Petition Under 37 CFR 1.47(A)" filed 23 October 2000 and "Supplemental Response to Decision on Petition Under 37 CFR 1.47 (A)" filed 08 November 2000, requesting that the present application be accepted for national stage processing without the signature of joint inventor Sergei Vasilievich Belyaev.

BACKGROUND

On 03 August 1998, applicant filed international application PCT/RU98/00250, which claimed priority of an earlier Russian application filed 04 August 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 February 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 February 2000.

On 03 February 2000, applicants filed national stage papers in the United States. The submission was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 20 April 2000, the United States Designated/Elected Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 19 May 2000, applicants filed a petition under 37 CFR 1.47(a) accompanied by, *inter alia*, an original declaration signed by two of the three joint inventors, the \$65.00 small entity fee for furnishing a declaration later than thirty (30) months from the priority date, and the \$130.00 petition fee required by 37 CFR 1.17(i).

On 26 June 2000, applicants filed a declaration by applicants' attorney Vladimir Biriulin in support of the 19 May 2000 petition.

On 16 August 2000, the PCT Legal Office of the USPTO mailed a decision dismissing the 26 June 2000 petition on grounds that applicants had not provided an affidavit or declaration by the person having firsthand knowledge of a 06 March 2000 letter purportedly not responded to by the nonsigning inventor and that the petition did not identify the last known address of the nonsigning inventor.

On 23 October 2000, applicants filed the present renewed petition along with a declaration by Carl Cobb, the person having firsthand knowledge of communications with the nonsigning inventor.

On 08 November 2000, applicants filed a supplement to the renewed petition.

The U.S. Application Number appearing on the 23 October 2000 renewed petition and on the 08 November 2000 supplement ("09/485,165") does not match the U.S. Application Number of the present application ("09/485,168"). However, because the respective Attorney Docket Numbers are identical and because the respective U.S. Application Numbers differ in only one digit, it is apparent that the 23 October 2000 and 08 November 2000 communications were intended for the present application. Both papers have been matched with the present application file.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventor, (2) factual proof that the missing joint inventor refuses to join in the application or cannot be reached after diligent effort, (3) the fee set forth in 37 CFR §1.17(i), and (4) the last known address of the nonsigning joint inventor. See 37 CFR 1.47(a).

With regard to item (1), the petition filed 19 May 2000 was accompanied by a declaration by joint inventors Pavel Ivanovich Lazarev and Jury Alexandrovich Bobrov on their own behalf and on behalf of the nonsigning joint inventor Belyaev.

With regard to item (2), MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, the declaration by Cobb states that a copy of the application papers and a declaration form were sent to the nonsigning inventor Belyaev on 06 March 2000 (see paragraph 3 of Cobb's declaration). The copy of the 06 March 2000 letter (see "Exhibit 2" of the 26 June 2000 communication) shows a receipt acknowledgment with Belyaev's signature which appears to match that found on the Patent Right Assignment Contract (see "Exhibit 3" of the 26 June 2000 communication). Thus, applicants have demonstrated with reasonable certainty that a bona fide attempt was made to present a copy of the application papers to Belyaev for signature.

The declaration by Cobb further states that a letter was mailed to Belyaev on 19 June 2000, requesting that Belyaev sign the application papers (see paragraph 9 of Cobb's declaration and "Exhibit 7" of the 08 November 2000 communication). Although Cobb's declaration states that Belyaev received the 19 June 2000 letter on 15 July 2000 as evidenced by delivery confirmation receipts (see paragraph 9 of Cobb's declaration and "Exhibit 7" of the 23 October 2000 communication), an English language translation of the delivery confirmation receipts has not been provided. Thus, it cannot be determined at the present time that Belyaev received the 19 June 2000 letter or that his alleged non-response to the letter constitutes a refusal to sign the application papers.

With regard to item (3), applicants have provided the requisite fee.

With regard to item (4), the declaration by Cobb states the last known address of the nonsigning inventor.


CONCLUSION

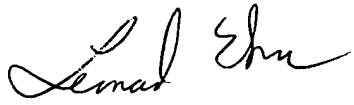
For the reasons above, the renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

Applicants filed a "Request for Refund" on 29 February 2000 along with a "Statement Claiming Small Entity Status" within two months of filing national stage papers on 03 February 2000. Pursuant to 37 CFR 1.28(a)(1), applicants' request for a refund of one half of the basic national fee is GRANTED. A refund of \$485.00 will be credited to Deposit Account No. 12-0425.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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